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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/584,111 01/11/96 LUHM

R, 003471.P010

CONLEY, F EXAMINER

35M1/0806

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ART UNIT

PAPER NUMBER

3508

DATE MAILED:

08/06/96

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Part III DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-2, drawn to a method for creating a hole, classified in Class 29, subclass 93.1.

Group II. Claims 3-9, drawn to a blind fastener, classified in Class 411, subclass 70.

2. Inventions I and II are related as a method for fastening a first and second workpiece. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the process of forming a hole for a permanent fastener can be practiced by a hand tool, drill, or impact driven tool.

3. Because these inventions are distinct for the reasons given above and have acquired a separated status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Blakely on July 19, 1996 to request an oral election to the above restriction requirement. An election was made for Group II, and claims ³⁻⁹~~1-4~~ were indicated to be readable upon the elected apparatus.

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5. Claims 1-2 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to the nonelected process. Election was made **without** traverse in Paper No. 2.

Information Disclosure Statement

6. The information disclosure statement filed 01/09/96 fails to comply with 37 CFR § 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered as to the merits.. References AA-AL have not been considered since copies of each patent have not been provided in the information disclosure statement.

Claim Rejections - 35 USC § 112

7. Claims 4 and 9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency between the language in the preamble and certain portions in the body of the claim, thereby making the scope of the claim unclear. The preamble in claims 4 and 9 clearly indicate that a subcombination is being claimed, e.g., "a fastener for use with a drill bit...." This language

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would lead the examiner to believe that the applicant intends to claim only the subcombination of "a fastener," the drill bit being only functionally recited. This presents no problem as long as the body of the claim also refers to the drill bit functionally.

The problem arises when the drill bit is positively recited within the body of the claim, such as, "...said conical shaped head has a diameter that is less than a drill bit..." There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a tacking fastener and a drill bit are being claimed. The examiner cannot be sure if applicant's intent is to claim merely the tacking fastener or the tacking fastener in combination with the drill bit.

Applicant is required to clarify what the claims are intended to be drawn to, i.e., either the tacking fastener alone or the combination of the tacking fastener and the drill bit. Applicant should make the language of the claim consistent with applicant's intent. In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the

intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 3-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 3,657,957 to Siebol.

In reference to claims 3-9, Siebol '957 discloses a fastener that is used to combine a first and second workpiece (11,12) with a shank 13 having an inner channel and a conical shaped head 14, a stem having a tapered head 22, inner cavity (40a,40z), and a serrated pull portion (col. 3 lines 26-30).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The list of prior art contain methods of constructing fasteners.

U.S. Pat. No. 4,702,655 to Kendall

U.S. Pat. No. 5,006,024 to Siebol

U.S. Pat. No. 2,536,353 to Cooper

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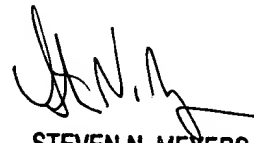
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U.S. Pat. No. 4,407,619 to Siebol

U.S. Pat. No. 4,781,501 to Jeal et al.

11.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fredrick C. Conley whose telephone number is (703) 308-7468.



STEVEN N. MEYERS
SUPERVISORY PATENT EXAMINER
GROUP 3500

F.C.

July 29, 1996